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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/284,339	04/13/1999	HISASHI TAKAYAMA	1900/005	2180
7590	08/11/2005		EXAMINER	
MORRIS LISS POLLOCK VANDE SANDE & AMERNICK PO BOX 19088 WASHINGTON, DC 200363425			JASMIN, LYNDY C	
			ART UNIT	PAPER NUMBER
			3627	

DATE MAILED: 08/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/284,339	TAKAYAMA, HISASHI
Examiner	Art Unit	
Lynda Jasmin	3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 18 May 2005.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 203-236 is/are pending in the application.
- 4a) Of the above claim(s) 203-232, 234 and 235 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 233 and 236 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>8/1/05</u> .	6) <input type="checkbox"/> Other: _____

**DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 18, 2005 has been entered.

***Election/Restrictions***

2. Newly submitted claims 203-232, 234, and 235 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the mobile electronic commerce or an IC card in a mobile electronic commerce system have different effects and/or functions of the originally presented invention.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 203-232, 234 and 235 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claim 233 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claim is directed to neither a "process" nor a "machine," but rather embrace or overlap two different statutory classes of invention. The claims begin by discussing a system and the body of the claims discusses the specifics of a method. "A claim of this type is precluded by the express language of 35 U.S.C 101 which is drafted so as to set forth the statutory classes of invention in the alternative only." See MPEP §2173.05(p) II or *Parte Lyell*, 17 USPQ2d 1548 (B.P.A.I., 1990).

#### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 233 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 233, the claim is directed to neither a "process" nor a "machine," but rather embrace or overlap two different statutory classes of invention. It is therefore unclear whether Applicant is claiming a process or a machine. See MPEP §2173.05(p) II or *Parte Lyell*, 17 USPQ2d 1548 (B.P.A.I., 1990).

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 233 and 236 are rejected under 35 U.S.C. 102(b) as being anticipated by Hiroya et al. (EP 0713198).

Hiroya discloses an electronic commerce system having at least a mobile user terminal (via terminal device 3) with a remote wireless communication section and a local wireless communication section (via communication line such as phone line and/or radio communication; col. 6, liens 41-54); a service providing system that communicates with the mobile user terminal (via electronic vending device and refunding device); an examination terminal (col. 12, lines 32-38); a mobile user terminal making a request for a purchase of electronic value card information via the remote wireless communication system (col. 8, lines 21-27); generating electronic value card information having at least one key data for use in a mutual challenge response authentication process executed between the mobile user terminal and the examination terminal in line of sight of a user of the mobile user terminal via the local wireless (col. 9, lines 4-22); issuing the electronic value card information to the mobile user terminal after a payment is settled (col. 9, lines 4-22; see steps 330-490 of Figure 5).

Hiroya further discloses transmitting to the service providing system a message that certifies use of the electronic value card information to the service providing system and that is electronically signed with a unique key included in the electronic card information (col. 9, lines 4-22).

***Response to Arguments***

9. Applicant's arguments with respect to claims 203-236 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

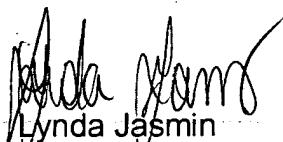
10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Davis et al. discloses smart card payment using the internet.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lynda Jasmin whose telephone number is (571) 272-6782. The examiner can normally be reached on Monday- Friday (9:30-6:00) with Thursday Telework.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3627

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Lynda Jasmin  
Primary Examiner  
Art Unit 3627

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